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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,580	03/15/2004	Kenji Inoue	KIN99USA	1657

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,580

Applicant(s)

INOUE, KENJI

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. In claim 1, it is not clear what is meant by "high molecular weight" because it is not clear whether this refers to number average or weight average molecular weight and also because the term "high" in claim 1 is a relative term which renders the claim indefinite. The term "high" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification does not define what values would be considered high.
3. In claim 2, it is not clear how claim 2 can be dependent on itself.
4. In claim 3, it is not clear what is meant by "the official moisture regain". How is this measured?
5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-10 of copending Application No. 10/764,618 in view of Westerkamp, US Patent Application Publication 2002/0060057. Claims 1, 9-10 disclose a wet paper web transfer belt comprising a high molecular weight elastic material having fibers which protrude from the elastic material. The claims differ from the claimed invention because they do not disclose the hydrophilic surface coating. Westerkamp teaches at paragraph 0029 that the upper layer of a papermaking belt can be rendered hydrophobic, hydrophilic, stain releasing or anti-static depending on the particular properties of the fiber suspension. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a hydrophilic coating to the surface of the belt disclosed in claims 1, 9-10 as taught by Westerkamp. One of ordinary skill in the art would have been motivated to apply the coating in order to harmonize the surface of the belt with the fiber suspension as taught by Westerkamp.

This is a provisional obviousness-type double patenting rejection.

7. Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/664,628 in view of Westerkamp, US Patent Application Publication 2002/0060057. Claims 1-9 disclose a wet paper web transfer belt comprising a high molecular weight elastic material having fibers which protrude from the elastic material. The claims differ from the claimed invention because they do not disclose the hydrophilic surface coating. Westerkamp teaches at paragraph 0029 that the upper

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layer of a papermaking belt can be rendered hydrophobic, hydrophilic, stain releasing or anti-static depending on the particular properties of the fiber suspension. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a hydrophilic coating to the surface of the belt disclosed in claims 1-9 as taught by Westerkamp. One of ordinary skill in the art would have been motivated to apply the coating in order to harmonize the surface of the belt with the fiber suspension as taught by Westerkamp.

This is a provisional obviousness-type double patenting rejection.

8.

9. In claim 4, the dependency on claim 1 makes claim 4 a duplicate of claim 2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-89990 in view of Westerkamp, US Patent Application Publication 2002/0060057. JP '990 discloses a wet paper transfer belt comprising an elastomer layer and a nonwoven layer wherein at least a portion of the nonwoven layer is exposed on the wet paper side. See page 3 of Applicant's specification as well as the machine translation which is attached. JP '990 differs from the claimed invention because JP '990 discloses

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the wet paper facing side of the belt comprises a hydrophobic coating. Westerkamp teaches at paragraph 0029 that the upper layer of a papermaking belt can be rendered hydrophobic, hydrophilic, stain releasing or anti-static depending on the particular properties of the fiber suspension. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a hydrophilic coating to the surface of JP '990 as taught by Westerkamp. One of ordinary skill in the art would have been motivated to apply the coating in order to harmonize the surface of the belt with the fiber suspension as taught by Westerkamp.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c